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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,527

01/26/2006

Richard Anthony Lang

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38155

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04/03/2008

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EXAMINER

DAVIS, RUTH A

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

04/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,527	Applicant(s) LANG ET AL.	
	Examiner Ruth A. Davis	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election of group I, claims 11 – 16 with traverse in the reply filed on January 18, 2008 is acknowledged. Upon further consideration of the claims, the groups were determined to share a special technical feature which contributes over the prior art. Thus, the restriction requirement has been WITHDRAWN. Claims 11 – 27 are pending and have been considered on the merits.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 – 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 and its dependents are drawn to a method for evaluating test substances, however are rendered vague and indefinite because the preamble is unclear as to what the test substance is being evaluated for. Specifically, the phrase “evaluating in vivo a test substance for growth” is confusing, as it is unclear if the test substance induces or prevents growth of the vascular tissue. To more clearly claim the invention, applicant may prefer to replace the

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preamble with: “An in vivo method for evaluating whether a test substance induces or promotes growth of new vascular tissue”.

Claims 11, 17 and 23 are further indefinite because it is unclear how a rodent pup has a papillary membrane, as the fetal membrane normally atrophies during gestation. It is unclear if the pups are intended to be fetal pups, or not.

Claim 12 is rendered indefinite because the claim does not clearly set forth what the “control” must be. Specifically a positive or negative control, or a pup with or without new vascular growth. It is further confusing for reciting “comparing the new growth” as the independent claim does not require growth, but rather is examined for growth or no growth.

In claims 15 and 16, line 1, “the examination” lacks antecedent basis. Applicant may prefer to replace the phrase with “the examining step”.

In claims 15 and 16, line 1, the recitation of “by” is unclear. Applicant may prefer to replace the term with “is carried out by” and to remove the term “a”, to more clearly claim the invention.

Claim 17 and its dependents are drawn to a method for evaluating test substances, however are rendered vague and indefinite because the preamble is unclear as to what the test substance is being evaluated for. Specifically, the phrase “evaluating in vivo a test substance for inhibiting or preventing growth” is confusing, as it is unclear if the test substance induces the claimed effects on vascular tissue. To more clearly claim the invention, applicant may prefer to replace the preamble with: “An in vivo method for evaluating whether a test substance inhibits or prevents growth of new vascular tissue”.

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In claim 17, step b, applicant may prefer to remove the term “can” and positively state that the “first substance that induces” new vascular growth to more clearly claim the invention.

In claim 17, step c is confusing, as it appears that the method is determining whether a test substance has an inhibiting effect on growth of new vascular tissue, however the step requires that the test substance have a known activity for regressing angiogenesis. Applicant may prefer to delete the phrase “an angiogenic regressor” and replace it with “a”.

Claim 19 is rendered indefinite because the claim does not clearly set forth what the “control” must be. Specifically a positive or negative control, or a pup with or without new vascular growth. It is further confusing for reciting “comparing the new examined tissue growth” as the independent claim does not require growth, but rather is examined for growth or no growth.

In claim 22, line 1, “the examination” lacks antecedent basis. Applicant may prefer to replace the phrase with “the examining step”.

In claim 22, line 1, the recitation of “by” is unclear. Applicant may prefer to replace the term with “is carried out by” and to remove the term “a”, to more clearly claim the invention.

Claim 23 and its dependents are drawn to a method for evaluating test substances, however are rendered vague and indefinite because the preamble is unclear as to what the test substance is being evaluated for. To more clearly claim the invention, applicant may prefer to replace the preamble with: “An in vivo method for evaluating the effect of a small molecule test substance on a property of a capillary vessel structure”.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth A. Davis whose telephone number is 571-272-0915. The examiner can normally be reached on M-F 7:00 -3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ruth A. Davis/
Primary Examiner, Art Unit 1651

March 28, 2008